



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,867	10/26/2000	Masahiro Konishi	MAS.003	3192

21254 7590 05/22/2003

MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

LE, LANA N

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 05/22/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,867

Applicant(s)

KONISHI, MASAHIRO

Examiner

Lana Le

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al (US 6,330,244) in view of Sashihara (US 6,434,405).

Regarding claim 1, Swartz et al discloses a wireless telephone 12A that receives data of at least one of an image and characters (to be viewed on a display screen) through a transmitting provider 14; col 17, lines 55-57), the wireless telephone comprising:

an inherent detector for detecting the data received from the transmitting provider;

a wireless communicating device 12A that communicates with the apparatus without the transmitting provider 14;

a designating device for designating the data for reception by the wireless telephone 12A from the transmitting provider (col 7, lines 44-65).

selectively designating an apparatus to which the received data is to be transmitted to the wireless communicating device transmits the data to the apparatus designated by

Art Unit: 2685

the designating device (col 17, lines 54-67). Swartz et al didn't further disclose the transmission between the designated apparatus and the mobile unit is wireless.

Sashihara discloses the transmission between the designated apparatus and the mobile unit is wireless (abstract; col 4, lines 15-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the wireless connection in order to avoid the inconvenience of using a cable/line connection.

Regarding claim 2, Sashihara and Swartz et al discloses the wireless telephone as set forth in claim 1, wherein Swartz et al further discloses the wireless phone further comprising a displaying device that displays a menu for designating the data for reception by the wireless telephone (col 15, lines 29-51) and displays received information on data of the at least one image and characters through the transmitting provider (col 7, line 33 - col 8, line 65; col 15, lines 29-51).

Regarding claim 3, Swartz et al further discloses the wireless telephone as set forth in claim 2, wherein the displaying device displays the received information (col 17, line 28-61); and the designating device allows the user to designate the data to be received from the information displayed by the displaying device (col 17, lines 54-65).

Regarding claim 7, Swartz et al discloses a data transmission system, comprising:

a wireless telephone 12A that receives data of at least one of an image and characters (email) through a transmitting provider ;

a designating device on said wireless telephone for designating the data for reception by the wireless telephone 12A using the mobile's IP address (col 7, lines 44-65).

selectively designating an apparatus to which the received data is to be transmitted and displaying a designating address of the apparatus (such as the PC's id workstation number (col 17, lines 54-67).

a display on said wireless telephone for displaying information from the received data (col 7, lines 33-65).

a wireless communicating device 12A that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device (col 17, lines 54-67). Swartz et al didn't disclose the communication with the apparatus is wireless communication. However, Sashihara discloses the communication from mobile 3 with the apparatus 5 is wireless communication (col 4, lines 15-21; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the connection of Swartz et al with the wireless communication in order to avoid the mess of cable connection to the mobile.

Regarding claim 8, Swartz further discloses the system of claim 7, wherein said wireless telephone receives and transmits the data without storing the entire data set on the wireless telephone by redirecting the data to another device for storage (col 17, lines 54-65).

Art Unit: 2685

2. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara (US 6,434,405) in view of Swartz et al (US 6,330,244).

Regarding claim 4, Sashihara discloses a data transmitting method for a wireless telephone 3, comprising:

detecting the data to be received from a transmitting provider (col 4, lines 15-18);

designating the data for reception by the wireless telephone (email addressed to the particular user) from the transmitting provider (col 4, lines 18-20);

receiving the data into the wireless phone from the transmitting provider, the data comprising at least one of an image and characters (email; col 4, lines 41-47) and communicating wirelessly with a peripheral apparatus (abstract, col 4, lines 15-21).

Sashihara didn't further disclose:

designating an apparatus to which the received data is to be transmitted; and

transmitting the data to the designated apparatus with a wireless communicating device that communicates with the apparatus without the transmitting provider.

Swartz et al further discloses designating an apparatus to which the received data is to be transmitted; and transmitting the data to the designated apparatus with a wireless communicating device that communicates with the apparatus without the transmitting provider (col 17, lines 54-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the designating an apparatus to Sashihara in order to forward the data to another device from the wireless phone for viewing when the mobile does not have enough display or memory capabilities to view the entire data file.

Regarding claim 5, Swartz et al further discloses the data transmitting method for the telephone as set forth in claim 4, further comprising the step of displaying that the telephone has received information on data of the at least one of image and characters through the transmitting provider (col 7, lines 33-65).

Regarding claim 6, Swartz et al further discloses the data transmitting method for the telephone as set forth in claim 5, wherein: the displaying step comprises the step of displaying the received information (col 8, lines 12-65); and the data to be received is designated from the received information to fit with the mobile phone's constraints (col 17, lines 54-62).

2. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (US 6,317,609) in view of Swartz et al (US 6,330,244) and further in view of Sashihara (US 6,434,405)

Regarding claim 15, Alperovich discloses transmitting data (digital image 355) from a first wireless telephone 20a to a second wireless telephone 20b through a transmitting provider 230 (fig. 4; col 5, lines 2-9);

detecting, on the second wireless telephone, the data to be received from the first wireless telephone when the image is detected and determined to be in a compatible format with the second mobile phone (col 6, lines 36-41);

displaying information from the detected data on a display on the second wireless telephone (col 6, lines 36-41, lines 52-64).

designating the data for reception by the second wireless telephone (col 4, lines 47-59); receiving the data into the second wireless telephone (col 6, lines 11-14).

Art Unit: 2685

However, Alperovich didn't further disclose:

designating an apparatus to which the received data is to be transmitted from the second wireless telephone; and

transmitting the designated data to the designated apparatus through a wireless connection device installed on the second wireless telephone.

Swartz et al discloses a method for transmitting data over a transmitting provider, comprising:

designating an apparatus to which the received data is to be transmitted from the second wireless telephone (col 17, lines 54-65); and

transmitting the designated data to the designated apparatus through a wireless connection device installed on the second wireless telephone (col 17, lines 54-65).

Alperovich and Swartz et al didn't further disclose the communication with the apparatus is wireless communication. However, Sashihara discloses the communication from mobile 3 with the apparatus 5 is wireless communication (col 4, lines 15-21; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the connection of Swartz et al with the wireless communication in order to avoid the mess of cable connection to the mobile and to add the designating apparatus to Alperovich et al in order to transfer the image/data file to another peripheral device when the wireless phone doesn't have enough capacity to load the entire sent data.

Regarding claim 16, Swartz further discloses the method of claim 15, wherein said receiving and transmitting said data with the second wireless telephone comprises

Art Unit: 2685

receiving and transmitting a data file on the second wireless telephone without storing the entire data set on the second wireless telephone when the phone doesn't have enough space to load the data onto the screen (col 17, lines 54-65).

Regarding claim 17, Alperovich further discloses the method of claim 15, wherein said displaying information from the received data on a display comprises displaying a received data file as one of an index image, a title, and a file name (fig. 4; col 5, lines 2-9);

Regarding claim 18, Alperovich et al, Sashihara, and Swartz et al discloses the method of claim 15, wherein Swartz et al further discloses displaying information from the detected area on a display includes displaying a menu having selections for a receive mode for indicating that data has been received (col 8, lines 25-50), a receive mail mode for receiving characters (col 7, lines 33-43), and a transmit mail mode for transmitting characters (col 7, lines 33-43) and wherein Alperovich et al further discloses a second phone 20b receiving a DI (digital image; fig. 4) wherein Swartz et al further discloses a transmit image mode for transmitting data from a phone to an apparatus (col 17, lines 54-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a receiving phone that receives the data through the network and for that phone to forward the data to a peripheral device on its side when the mobile device cannot load the entire data.

Regarding claim 19, Swartz et al further discloses the method of claim 15, further comprising:

comparing the size of the data to be received into the second wireless telephone with

Art Unit: 2685

memory capacity of the second telephone to determine if data can be stored on the telephone or must be outputted to an apparatus (col 17, lines 50-65).

Regarding claim 20, Swartz et al further discloses the method of claim 15, wherein said transmitting the designated data to the designated apparatus through a wireless connection device includes designating addresses of apparatuses to which the data is to be transmitted (ie. the PC's workstation id; col 17, lines 55-67).

4. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara (US 6,434,405) in view of Swartz et al (US 6,330,244) and further in view of Alperovich (US 6,317,609).

Regarding claim 9, Sashihara and Swartz et al discloses the system of claim 7, wherein they didn't further disclose the system comprising:

a second wireless telephone that receives the data from a computer and transmits the data into the wireless telephone through the transmitting provider

Alperovich et al further discloses the system comprising:

a second wireless telephone 20b that receives the data from a computer and transmits the data into the wireless telephone through the transmitting provider (fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the second wireless phone in order to send the image/data to a friend's cell phone for him/her to view.

Regarding claim 10, Swartz et al further discloses the system of claim 9, wherein the second wireless telephone of Alperovich et al receives the data from a computer

Art Unit: 2685

server and transmits the data to a peripheral device such as a PC without storing the entire data set on the second wireless telephone (col 17, lines 54-65).

Regarding claim 11, Sashihara and Swartz et al discloses the system of claim 7, wherein Sashihara and Swartz et al didn't specifically disclose a second telephone. Alperovich et al further discloses a second phone (fig. 4). Swartz et al discloses the system further comprising:

a central processing unit for controlling the telephone and for comparing the size of the data to be received into the wireless telephone with memory capacity of the second telephone of Alperovich et al to determine if data can be stored on the telephone or must be outputted to an apparatus (col 17, lines 50-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine if the data of the receiving phone of Alperovich et al is too large for the phone to load and therefore forward the data to another peripheral device on the second phone's side.

Regarding claim 12, Swartz et al further discloses the system of claim 11, wherein said central processing unit compares the size of the data to be received with memory capacity of the wireless telephone to determine if data can be stored on the telephone or must be outputted to the apparatus (col 17, lines 50-65).

Regarding claim 13, Sashihara and Swartz et al discloses the system of claim 7, wherein Swartz et al further discloses said display device includes a menu having selections for a receive mode for indicating that data has been received (col 8, lines 25-

Art Unit: 2685

50), a receive mail mode for receiving characters (col 7, lines 33-43), and a transmit mail mode for transmitting characters (col 7, lines 33-43).

Sashihara and Swartz et al didn't disclose a second phone. Alperovich et al further discloses a second phone 20b receiving a DI (digital image; fig. 4) wherein Swartz et al further discloses a transmit image mode for transmitting data from a phone to an apparatus (col 17, lines 54-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a receiving phone that receives the data through the network and for that phone to forward the data to a peripheral device on its side when the mobile device cannot load the entire data.

Regarding claim 14, Sashihara and Swartz et al discloses the system of claim 7, wherein Swartz et al further discloses the display device further comprises a menu having selections for a receive mode for indicating that data has been received (col 8, lines 25-50), a receive mail mode for receiving characters (col 7, lines 33-43), and a transmit mail mode for transmitting characters (col 7, lines 33-43).

Sashihara and Swartz et al didn't disclose a second phone. Alperovich et al further discloses a second phone 20b receiving a DI (digital image; fig. 4) wherein Swartz et al further discloses a transmit image mode for transmitting data from a phone to an apparatus (col 17, lines 54-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a receiving phone that receives the data through the network and for that phone to forward the data to a peripheral device on its side when the mobile device cannot load the entire data.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana Le whose telephone number is (703) 308-5836. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9315 for After Final communications.

Art Unit: 2685

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



Lana Le

May 5, 2003



NGUYEN T. VO
PRIMARY EXAMINER